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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/557,889	04/21/2000	Marcel Hofsaess	4965-000104	8394

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EXAMINER

VORTMAN, ANATOLY

ART UNIT PAPER NUMBER

2835

DATE MAILED: 11/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/557,889

Applicant(s)

HOFSAEISS, MARCEL

Examiner

Anatoly Vortman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2002 (RCE & PreAm.).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-27 is/are allowed.
- 6) ☒ Claim(s) 28-36 and 39-46 is/are rejected.
- 7) ☒ Claim(s) 37,38,47 and 48 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action (paper # 9) has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on 08/13/02 (paper # 10) and on 10/01/02 (paper # 13) have been entered. At this point claims 1-19 have been cancelled. New claims 20-27 have been added in paper #10 and new claims 28-48 have been added in paper # 13. Thus, claims 20-48 are pending in the instant application.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 28-36 and 39-46, are rejected under 35 U.S.C. 103(a) as being unpatentable over US/3,443,259 to Wehl et al., (Wehl).

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Regarding claims 28 and 39, Wehl disclosed an electrical device (Fig. 1-7), comprising an electrical load (column 1, lines 25-28), a housing (2), an external terminal (8) for supplying electricity to said load, a cavity provided in said housing (2), a first (6) and a second (13) countercontact being provided in said cavity, said first countercontact (6) being electrically connected to said load and said second countercontact (13) being electrically connected to said external terminal (8), and a housingless temperature-dependent switching mechanism (Fig. 7), said switching mechanism protecting said load from overtemperature and overcurrent, respectively (column 1, lines 25+), wherein said switching mechanism comprises a bimetallic element (9) and a movable contact element (13) and is inserted in said cavity such that said movable contact element (13) is, when its temperature is below its response temperature, in direct electrical contact with one of said first (6) and second (13) countercontacts for electrically interconnecting said first (6) and second (13) countercontact with each other (Fig. 1), but did not disclose that said housing part is designed to accommodate both: the electrical load and the switching mechanism, rather Wehl disclosed that said switch has it's own housing (2) and is used for protective purposes with small electric motors or home appliances (column 1, lines 25+), which inherently have their own housings.

It would have been obvious to a person of ordinary skill in the thermal switch art at the time the invention was made to combine the load (i.e. motor or appliance) and said switching mechanism in a single housing as an obvious design choice in order, for example to enhance the heat exchange between the load and the switching mechanism, since it has been held that forming in one piece an article (i.e. a single housing for the load and the switching mechanism) which has formerly been formed in two pieces (i.e. separate housings for the load and the

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switching mechanism) and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893). It does not amount to invention to make integral that which has therefore been in two or more parts. *In re Otto et al.*, 50 USPQ 149. It does not avoid infringement to combine into one member that which patent discloses as two, if single member performs duties of both in same way. *Royal Typewriter Co. v. Remington Rand, Inc.*, 77 USPQ 517 (CA 2 1948).

Regarding claims 39 and 41, Wehl additionally disclosed a cover (formed by members (7 and 4)) that sealingly closes off the cavity and one of the contacts (6) is arranged on said cover, (Fig. 3).

Regarding claims 29, 30, and 40, Wehl disclosed a cover (4, 7) that sealingly closes off the cavity in articulated fashion after the switching mechanism has been set in place (Fig. 1).

Regarding claims 31, 32, 42, and 43, Wehl disclosed that said switching mechanism is configured as a lossproof unit, wherein a spring element (11) is held in lossproof fashion on the contact element (13) that coacts with the other (6) of the two countercontacts.

Regarding claims 33, 34, 44, and 45, Wehl disclosed that the switching mechanism is attached to a guide element (4) that is inserted together with the switching mechanism into the cavity, wherein said guide (4) acts as a cover and closes off the cavity in sealed fashion.

Regarding claim 35, Wehl disclosed that one (6) of the two countercontacts is arranged on the cover (guide element) (4), (Fig. 3).

Regarding claims 36 and 46, Wehl disclosed (Fig. 8) that the bimetallic element (9') is configured as a bimetallic tongue that at its first end is attached to a guide element (7) being

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inserted together with the switching mechanism into the cavity, and at its free end carries the movable contact element.

Allowable Subject Matter

4. Claims 20-27 are allowed.

5. Claims 37, 38, 47, and 48, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter:
regarding claims 20-27, 37, and 47, claims 20, 25, 37, and 47 recite “the spring element is configured as a spring tongue that at its first end is attached to a guide element ... and at its second end is joined to a first end of the bimetallic element”;
regarding claims 38 and 48, claims recite “the spring element has retaining extension piece that is attached to a guide element”.

The aforementioned limitations in combination with remaining limitations of the claims, are believed to render said claims 20-27, 37, 38, 47, and 48 patentable over the art of record.

Response to Arguments

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7. Applicant's arguments filed on 10/01/02 (paper # 13) have been fully considered but they are not persuasive.

The main thrust of the Applicant's arguments is directed to the fact that allegedly one of ordinary skill in the thermal switch art would not be motivated to modify Wehl et al. device, since "such extensive modifications are not rendered obvious by the prior art." (page 8 of paper #13).

On the contrary, the Examiner believes that one of ordinary skill in the thermal switch art would be motivated to modify said device of Wehl et al., since there is no requirement that a motivation to make the modification be expressly articulated. It is important what disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA) 1969.

In this case, Wehl et al teaches that the switch has it's own housing (2) and is used for protective purposes with small electric motors or home appliances (column 1, lines 25+), which inherently have their own housings. Therefore, in Examiner's opinion, one of ordinary skill in the thermal switch art would have been motivated at the time the invention was made to combine the load (i.e. motor or appliance) and the switch in a single housing in order to enhance the heat exchange between the load and the switching mechanism.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anatoly Vortman whose telephone number is 703-308-7824. The examiner can normally be reached on 9:30-6:00, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Darren Schuberg can be reached on 703-308-4815. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3431 for regular communications and 703-305-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.

Anatoly Vortman
Primary Examiner
Art Unit 2835

A.V.
November 14, 2002

A handwritten signature in black ink, appearing to read 'A. Vortman', with a long horizontal line extending to the right.